

REMARKS

At the outset, Applicants wish to thank Examiner Morrison and his Supervisor, Examiner Walsh, for the courtesies extended to Applicants' representatives during the November 1, 2005 interview at the United States Patent & Trademark Office. The substance of the interview is incorporated in the following remarks.

Summary of the Office Action

In the Office Action, the drawings and claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as been indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 1-3 and 8-15 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,112,047 to *Kato et al.* (hereinafter "*Kato*").

Claim 4 is rejected under 35 U.S.C. §102(b) as being unpatentable over by *Kato*.

Claims 5-7 are rejected under 35 U.S.C. §103 (a) as being unpatentable over *Kato* in view of U.S. Patent Publication No. 2003/0116911 to *Kanai et al.* ("*Kanai*").

Summary of the Response to the Office Action

Claims 1-15 have been cancelled without prejudice or disclaimer, and new claims 22-36 have been added. Claims 16-21 are withdrawn. Accordingly, claims 22-36 are pending for consideration.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1-15 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants respectfully submit that this rejection is moot in light of the cancellation

of claims 1-15. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies With 35 U.S.C. § 102(b)

Claims 1-3 and 8-15 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,112,047 to *Kato et al.* (hereinafter “*Kato*”). The above-mentioned claims are cancelled, and thus their rejection moot. However, the *Kato* reference is considered below in view of the new claims 22-36.

Applicants respectfully submit that the Office Action has not established that *Kato* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claims 22 and 33 recite the features of “the sheet entering ports of the respective sheet discharge units are arranged at different positions with respect to the second sheet discharge ports.” At least these features are not disclosed or taught by *Kato*.

Kato discloses an image forming apparatus of the type having a sheet discharging section provided in an upper portion of a body of the apparatus, a stacking section for stacking a sheet driven out via the sheet discharging section, and a casing accommodating a sheet conveying mechanism. An inclined surface is formed on top of the stacking section and inclines obliquely downward toward the sheet discharge section. A guide on the bottom of the casing is used for sliding against the inclined surface when the casing is mounted to the body of the apparatus. See Abstract of *Kato*. However, *Kato* fails to teach or suggest at least the above feature of claims 22 and 33.

As discussed during the interview of November 1, 2005, *Kato* does not disclose at least “sheet entering ports of the respective sheet discharge units are arranged at different positions with respect to the second sheet discharge ports.” *Kato* shows, in Figs. 4 and 6, a sheet discharging unit 82 with a normal discharge path (out of 46 and then up along 84a), but then shows the sheet entering port and second sheet discharge port as being the same port. Because *Kato* does not disclose at least the second sheet discharge port is located separately from the sheet entering port, *Kato* cannot anticipate the invention recited in claims 22 and 33.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Kato* does not teach or suggest each feature of independent claims 22 and 33.

Additionally, Applicants respectfully submit that dependent claims 23-32 and 34-36 are also allowable insofar as they recite the patentable combinations of features recited in claims 22 and 33, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies With 35 U.S.C. § 103(a)

Cancelled claim 4 is rejected under 35 U.S.C. §102(b) as being unpatentable over by *Kato*. The above-mentioned claim is cancelled, and thus its rejection moot. However, the *Kato* reference is considered in view of the new claims 22-36.

As demonstrated above, *Kato* fails to disclose each and every feature of independent claims 22 and 33. M.P.E.P. § 2143.03, states that “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re*

Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that any rejection under 35 U.S.C. § 103(a) of the dependent claims should be withdrawn because *Kato* does not teach or suggest each and every feature of independent claims 22 and 33.

Any possible claims rejected under 35 U.S.C. §103 (a) as being unpatentable over *Kato* in view of U.S. Patent Publication No. 2003/0116911 to *Kanai et al.* ("Kanai") may be overcome because the subject matter in *Kanai* was, at the time the invention was made, owned by the same entity and was subject to an obligation of assignment to the same entity. M.P.E.P. § 706.02(l)(1), citing 35 U.S.C. § 103(C), states that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Thus, Applicants respectfully submit that the secondary reference, *Kanai*, should be removed as a reference.

With respect to the requirements of M.P.E.P. § 706.02(l)(2), Applicants herewith submit that:

"Application 10/749,392 and U.S. Patent Publication No. 2003/0116911 to *Kanai et al.* (i.e., Application 10/322,580) were, at the time the invention of Application 10/749,392 was made, owned by Fuji Xerox Co., Ltd."

Under M.P.E.P. § 706.02(l)(2), Applicants respectfully submit that this statement alone is sufficient evidence to disqualify *Kanai* from being used in a rejection under 35 U.S.C. 103(a)

against the claims of the present invention, Application 10/749,392. Therefore, Applicants respectfully request that any possible rejection under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner believe that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: Mary Jane Boswell
Mary Jane Boswell
Reg. No. 33,652

Dated: November 3, 2005

CUSTOMER NO. 09629

MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: (202) 739-3000
Facsimile: (202) 739-3001